

BLANK

PAGE

FILE COPY

Office - Supreme Court, U. S.
FILED

MAY 20 1937

CHARLES ELMORE CROPLEY
CLERK

Pat.

166.
IN THE

85796
M. & S. C.

Supreme Court of the United States

OCTOBER TERM, 1936.

No. 

72

CROWN CORK & SEAL COMPANY, INC., *Petitioner,*

v.

FERDINAND GUTMANN CO., INC., *Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT AND BRIEF IN SUPPORT OF PETITION
FOR WRIT OF CERTIORARI.**

THOMAS G. HAIGHT,
GEORGE F. SCULL,
JOHN J. DARBY,
GEORGE W. PORTER,
Counsel for Petitioner.

BLANK

PAGE

TABLE OF CONTENTS.

	Page
PETITION FOR WRIT OF CERTIORARI	1
Summary and Short Statement	2
Decision of Circuit Court of Appeals	3
Conflict between Circuit Court of Appeals in case at bar and other Circuit Courts of Appeals....	4
The Questions Presented	9
Public Importance of Questions Raised	9
Reasons Relied On For The Allowance of The Writ	12
BRIEF IN SUPPORT OF PETITION	15
Opinions of Courts Below	15
Jurisdiction	15
Statement of the Case	15
Specification of Errors	15
ARGUMENT	16
I. The Circuit Court of Appeals for the Second Cir- cuit has extended the doctrine of <i>Webster v. Split-</i> <i>dorf</i> beyond any thing justified by that or any other decision of this Court	16
II. There is an irreconcilable conflict between the Cir- cuit Courts of Appeals for the Second, First, Sixth and Eighth circuits as to the applicability of <i>Webster v. Splitdorf</i> to a case where claims have been inserted in a divisional application more than two years after the filing of the parent ap- plication but less than two years after there was an intervening public use, patent or publication..	20
III. There is a further irreconcilable conflict between the Circuit Courts of Appeals for the Second and Sixth Circuits as to what constitutes valid excuse for delay in presentation of claims in a divisional application	26

	Page
IV. The questions involved are of vital public importance	28
CONCLUSION	30
APPENDIX	31

TABLE OF CASES CITED.

<i>Altoona v. American Tri-Ergon</i> , 294 U. S. 477, 487....	8*, 26
<i>Chapman v. Wintroath</i> , 252 U. S. 135.....	3*, 16, 20
<i>Dubilier Condensor Corporation v. Radio Corporation of America</i> , 34 F. (2d) 450, 462 (D. C. Del.).....	24
<i>Hartford-Empire Company v. O'Bear-Nester Glass Co.</i> , 39 F. (2d) 769 (C. C. A. 8th)	6, 12
<i>MacLaren v. Stoetzel</i> , 38 F. (2d) 125, 129 (C. C. P. A.)	8, 28
<i>McGrath v. Burke</i> , 12 F. (2d) 161, 162 (Court of Appeals, D. C.)	8, 28
<i>United States v. American Bell Telephone Co.</i> , 167 U. S. 224, 247	6, 19
<i>Utah Radio Corp. Products v. Boudette</i> , 78 F. (2d) 793 (C. C. A. 1st)	5, 12, 21
<i>Wagenhorst v. Hydraulic Steel Co.</i> , 27 F. (2d) 27 (C. C. A. 6th)	5, 12, 18, 22
<i>Webster Co. v. Splitdorf Co.</i> , 264 U. S. 463.....	4, 12, 16
<i>Wirebounds Patents Co. et al. v. Saranac</i> , 37 F. (2d) 830 (C. C. A. 6th)	5, 12, 19*, 23

STATUTE CITED.

U. S. C., title 35, sec. 31	5*, 11
-----------------------------------	--------

*Footnote.

IN THE
Supreme Court of the United States

OCTOBER TERM, 1936.

No. _____

CROWN CORK & SEAL COMPANY, INC., *Petitioner,*

—
v.

FERDINAND GUTMANN Co., INC., *Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT.**

• • •
TO THE HONORABLE CHIEF JUSTICE AND ASSOCIATE JUSTICES
OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, Crown Cork & Seal Company, Inc., plaintiff, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit to review a judgment of that court rendered on January 22, 1937.

SUMMARY AND SHORT STATEMENT.

This action was brought by petitioner to enjoin infringement of two* Letters Patent, namely, Warth Reissue No. 19,117, dated March 20, 1934 (R., p. 711), hereinafter identified as the "parent" patent, and Warth patent No. 1,967,195, dated July 17, 1934 (R., p. 716), hereinafter identified as the "divisional" patent. The patents cover methods for applying a small disc of foil or paper, known as a "center spot", to the cork cushion discs of crown caps used for sealing high pressure beverages, such as beer and ginger ale. The center spot serves to protect the cork cushion from the sealed liquid in the manner illustrated in the sketch appended to the brief.

The District Court for the Eastern District of New York (Campbell, J.,) found both patents valid and infringed, 14 F. Supp. 255 (R., pp. 2047, 2072; decree p. 2107). The Circuit Court of Appeals for the Second Circuit (Manton, J., dissenting) reversed the decree, holding (R., pp. 2146, 2150) that the parent patent was not infringed and that the divisional patent was invalid because of laches in filing the application. The opinion of the Court of Appeals is reported at 86 F. (2d) 698.

The application for the parent patent was filed on January 7, 1927 (R., p. 1485) and matured into patent No. 1,788,260, dated January 6, 1931. Before the issuance of the parent patent, a second application had been filed (R., p. 1948) with the same disclosure. While the second application was pending, a patent to one Johnson, No. 1,852,578, issued on April 5, 1932 with claims covering specific subject-matter *disclosed* in the Warth original and second applications, but not then *claimed* in the pending second application. From the second application, Warth carved a divisional application, which resulted in the divisional patent in suit, and copied therein the claims of the Johnson

*Three other patents before the Court of Appeals are not involved in this petition.

patent* two years and four months after the parent Warth patent had issued. There is no issue here as to the propriety of filing the division instead of inserting the claims by amendment in the then pending second application.

In an interference with this Johnson patent, the Patent Office held the Warth divisional application entitled to the filing date of the parent Warth patent. This was in accord with the practice of the Patent Office for the past fifty years, as approved by this Court in *Chapman v. Wintroath* (252 U. S. 135). The claims of the Johnson patent were accordingly awarded to Warth as the prior inventor and are now the claims of the Warth divisional patent here in suit.

There had been no adverse public use or printed publication or other intervening right for more than two years before these claims were asserted by Warth in his divisional application.**

Decision of Circuit Court of Appeals

The Circuit Court of Appeals overruled the holding of the Patent Office, which followed its practice of over fifty years, and the holding of the District Court (R., p. 2101).

*Johnson is not involved in this suit. The Johnson patent claims were copied within a year after the patent had issued and therefore within the two years allowed by *Chapman v. Wintroath*, 252 U. S. 135.

**The Court of Appeals referred to the issuance of the Warth parent patent more than two years before the divisional patent claims were asserted, but the patent contained no description of the method of the Warth divisional patent and hence was not a printed publication. The Court of Appeals also referred to the Johnson patent, but this issued less than a year before the claims were asserted by Warth and hence is not a bar under the rule of this Court in the *Chapman* case, *supra*. Defendant's use of the invention was also urged as being more than two years prior to the Warth divisional application, but was found by the District Court not to anticipate (antedate) the filing date of the Warth divisional patent (R., p. 2100) and this finding was not disturbed by the Court of Appeals although defendant strenuously urged that such finding was error.

and held that the delay of two years and four months in asserting specific claims in Warth's divisional application invalidated such claims in the absence of a legal excuse, notwithstanding that the subject-matter of said claims had not been disclosed in any patent, publication or prior public use for two years or more before such claims were inserted. The Court said (R., p. 2153):

"The disclosure, however, had been continuously on file since January 7, 1927 (the filing date of the parent patent) and so the plaintiff contends that it is entitled to that filing date. We do not so understand the law, as laid down in *Webster v. Splitdorf*, 264 U. S. 463, 471, 44 S. Ct. 342, 343, 68 L. Ed. 792. Prima facie the two year limit applies to divisional applications, and an applicant who waits longer before claiming the invention disclosed in his application must justify his delay by proof of some excuse. No such excuse appears here."

The Court of Appeals (R., p. 2151) found that the Warth patent application originally "had claims sufficiently broad to cover it" (the specific subject-matter of the Warth divisional patent) but that such claims were cancelled on December 3, 1930. This was two years and four months before Warth again asserted claims to the specific subject-matter of his divisional patent. During this interval no intervening bar had arisen; see footnote, p. 3 *ante*.

Conflict between Circuit Court of Appeals in case at bar and other Circuit Courts of Appeals.

This interpretation of *Webster v. Splitdorf*, 264 U. S. 463, by the Circuit Court of Appeals for the Second Circuit directly conflicts with the interpretation of that case by the Circuit Courts of Appeals for the First Circuit and for the Sixth Circuit. Each of these last-named Courts has held the doctrine of the *Webster* case to apply only where there has been an adverse public use, a printed publication, or other intervening right more than two years

before the claims were presented. See the quotations in the brief, pp. 21, 23, from the following decisions:

Utah Radio Corp. Products v. Boudette, 78 F. (2d) 793 (C. C. A. 1st).

Wagenhorst v. Hydraulic Steel Co., 27 F. (2d) 27 (C. C. A. 6th).

Wirebounds Patents Co. et al. v. Saranac, 37 F. (2d) 830 (C. C. A. 6th).

Furthermore, the interpretation of the *Webster* case by the Court of Appeals for the Second Circuit conflicts with the practice of the Patent Office for over fifty years. The Patent Office had always accorded a divisional application the benefit of the filing date of the parent application for all subject-matter common to the two applications, whether such subject-matter had been claimed in the parent application or not. The only exception, regardless of the lapse of time in presenting the claims in the divisional case, had been where the rights of others intervened more than two years before the claims were presented. This practice by the Patent Office has been in accordance with the decisions of this Court in *Chapman v. Wintroath* and *Webster v. Splitdorf*, *supra*, by analogy to the fundamental statute* which prohibits the issuance of a patent to the first inventor only if there has been a public use, printed publication

*Sec. 4886. (U. S. C., title 35, sec. 31) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

or sale more than two years before the application for patent.

Obviously, this conflict in interpretation of the decision in *Webster v. Splitdorf* should be resolved by this Court. We submit that the interpretation by the Court of Appeals for the Second Circuit is not correct, because it establishes a bar to the grant of a patent not embodied in the fundamental statute. As this Court held in the *Chapman* case, *supra*, any bar established by a Court to the grant of a patent should be reconcilable with that statute and no Court can disregard any statutory provisions in respect to these matters "on the ground that, in its judgment, they are unwise or prejudicial to the interest of the public." *United States v. American Bell Telephone Co.*, 167 U. S. 224, 247.

The conflicting interpretations of the *Webster* case by the several Circuit Courts of Appeals is further emphasized by the decision of the Circuit Court of Appeals for the Eighth Circuit in *Hartford-Empire Company v. O'Bear-Nester Glass Co.*, 39 F. (2d) 769, which holds that if claims are presented in a divisional application more than two years after the filing of the parent application and a patent has issued to another at any time prior to the presentation of the claims, the claims are barred. **See the quotation from the Hartford decision in the brief, p. 24, *infra*.**

Under this rule the Johnson patent, issued *less than a year* before the Johnson patent claims were presented in the Warth divisional application, would invalidate the Warth divisional patent claims, although this Court in the *Chapman* case held that the claims of such a patent may be made at any time within two years.

Consequently, the Court of Appeals for the Eighth Circuit follows more closely the interpretation of the *Webster* case by the Court of Appeals for the Second Circuit in the case at bar than the interpretation by the Courts of Appeals for the First and Sixth Circuits. Yet, the Court of Appeals for the Eighth Circuit recognized the confusion when it said (at 775):

"The point is one with which, and with its variables upon varying facts, the courts have *had much trouble*.* The law is yet seemingly in the process of crystallization as to what shall be the final rule. (Citing: *Chapman v. Wintroath*, *Webster v. Splitdorf*, *supra*, and other cases.)"

A second question presented and as to which the decision of the Circuit Court of Appeals in the case at bar conflicts with another Circuit Court of Appeals, is whether, assuming an excuse is required, the fact that the claims of the Warth parent patent were intended and believed to, and apparently do, cover the subject-matter of the Warth divisional patent claims, is an excuse for the lapse of over two years in presenting the divisional patent claims.

The Court of Appeals, reversing the District Court, held that, although Warth had claimed broadly the invention of the divisional patent prior to December 1930 in the parent application, the claims of his parent patent did not cover the divisional patent subject-matter, and that the subject-matter was not again claimed until two years and four months thereafter in the application for the divisional patent.

It is settled that more than two years lapse or delay, even after an intervening right may be excused "by special circumstances which show it to have been not unreasonable" (*Webster v. Splitdorf*, *supra*). The Courts are also in agreement that, if a parent patent has claims broad enough in scope to include a specific form of the invention, then more than two years delay in asserting, in a divisional application, claims limited to such specific form is not unreasonable and is excused. The Court of Appeals for the Second Circuit so held (R., p. 2153).

In the case at bar, the "special circumstance" offered as an excuse, is that the claims of the parent Warth patent *were intended to and, on their face, are broad enough to*

*Italics ours throughout unless otherwise stated.

cover the specific form of the invention claimed in the divisional patent. And the plaintiff believed they did. Moreover, the District Court held that the parent patent claims are of sufficient breadth to cover the subject-matter of the divisional patent claims. (R., p. 2082)

Such an excuse for delay was accepted by the Court of Appeals for the Sixth Circuit in the *Wagenhorst* case,* *supra*, but was rejected by the Court of Appeals for the Second Circuit in the case at bar, although petitioner urged that as an excuse for delay. Instead, by an arbitrary reading of a limitation into the claims** of the Warth parent patent, the Court so limited the scope of those claims as to exclude the subject-matter of the divisional patent and then held that the claims thus interpreted presented no excuse for delay.

Other courts have held that delay in presenting claims is excused and abandonment is negated when, as here, an inventor believed, mistakenly or not, that he had broadly covered the invention by an earlier filed application. See: *McGrath v. Burke* (Court of Appeals, D. C.) 12 F. (2d) 161, 162; *MacLaren v. Stoetzel* (C. C. P. A.) 38 F. (2d) 125, 129. These cases are in point, since the question involved was, as in the case at bar, whether the applicant for patent exercised diligence in presenting claims.

The refusal of the Court of Appeals for the Second Circuit to excuse the delay in presenting the claims of the divisional patent directly conflicts with the decision of the

*In the *Wagenhorst* case, the Court, excusing delay in presenting claims in a divisional application because of the apparent breadth of claims in the parent application, said (at 31): "It may be said, with some certainty as to original claim 2, and with some probability as to claims 1 and 3, that, if granted, they would have seemed to cover defendant's later structure, and might or might not have been construed in that way."

**This was done notwithstanding the rule of this Court in *Altoona v. American Tri-Ergon*, 294 U. S. 477, 487, that a claim should not be construed "by reading into it parts of the specifications • • which the patentees failed to include in it."

Court of Appeals for the Sixth Circuit in the *Wagenhorst* case wherein it was held that it is the *seeming* scope of the claims of the parent application which is the determining factor, regardless of whether such claims might or might not be finally construed broadly.

Obviously, this conflict of decisions between the two Circuit Courts of Appeals should be resolved by this Court. It is submitted that the ruling of the Court of Appeals for the Sixth Circuit is correct and that under the same it was reasonable* for Warth to rely on the apparent and intended scope of the parent patent claims, regardless of the final limited construction given to such claims by the Court of Appeals for the Second Circuit.

THE QUESTIONS PRESENTED.

1—Does this Court's decision in *Webster v. Splitdorf* mean that, *even in the absence of intervening adverse rights*, an excuse must be shown for a lapse of more than two years in presenting claims in a divisional application regularly filed and prosecuted in accordance with the Patent Office rules?

2—Where there has been more than two years delay in asserting specific claims in a divisional application, is it an excuse for the delay that there were claims in the parent patent which, on their face, covered and were reasonably believed to cover, the subject-matter of the divisional claims, even if a Court later interpreted the parent patent claims not to cover such subject-matter?

Public Importance of Questions Raised.

Because of the conflicting interpretations of this Court's decision in the *Webster* case, there is great confusion as to

*The finding of the District Court (R., p. 2082) that the claims of the parent patent are broad enough to include the specific form of the invention defined in the divisional patent claims is evidence of the reasonableness of Warth's conduct.

the rights and duties of applicants for divisional patents. Divisional applications represent a very large percentage of cases prosecuted before the Patent Office* and divisional patents a corresponding large percentage of those granted. This Court, in the *Chapman* and *Webster* cases, has already recognized the importance of divisional applications and patents and that they should be favored "designed as they are to secure the patent to the first discoverer".

Under the rule established by the Court of Appeals for the Second Circuit in this case, the practice of the Patent Office with respect to claims presented in divisional applications is incorrect, and numerous invalid divisional patents are being granted. It is vital that the public know to what extent these patents are enforceable.

Moreover; the confusion which has arisen from the conflicting interpretation of this Court's decision in the *Webster* case by the Patent Office and the various Courts of Appeals has given rise to great uncertainty as to (a) under what circumstances the two year limit shall be applied, and (b) when the limit begins to run.

The exception in the *Webster* case to the rule of this Court that divisional applications are entitled to the filing dates of parent applications for any matter disclosed in the latter, whether claimed or not, should be made definite in the interest of the public and inventors alike.

As to the secondary question, this Court has never decided whether facts such as presented here are an excuse for a delay in presenting claims in a divisional application. The Court of Appeals for the Sixth Circuit in the *Wagenhorst* case has held that the presence of claims in the parent application, on which the patentee reasonably relied as covering the invention, constitutes an adequate excuse for

*For example, in 1934 and 1935, the last years records were maintained by the Patent Office, approximately every eighth applicant for patent was required to file divisional applications to protect his full disclosure. In 1934, examination of applications resulted in 7162 requirements for divisions and in 1935, 7609 requirements.

delay. The Court of Appeals for the Second Circuit in the case at bar has held to the contrary. Manifestly, it is of great importance that this conflict be resolved by this Court.

It is to the interest of both inventors and the public that divisional applications be favored. This Court's statement in the *Chapman* case, *supra*, that divisional applications are not to be treated in a "hostile spirit", is a recognition of their importance.

Encouragement of divisional applications induces inventors to file disclosures of their inventions promptly and completely. As this Court said in the *Chapman* case, divisional applications facilitate the determination of the first inventor to whom the patent should issue under the statute.

It is an everyday occurrence for an inventor, in his aim to file a full disclosure, to describe more than a single invention. Not infrequently, the inventor is unaware at the time of filing that certain phases of his disclosure are inventions and must be separately and specifically claimed. It is not unusual for an inventor to realize only more than two years after filing his application the necessity for *specific* claims to certain phases of his original disclosure. Before the rule by the Circuit Court of Appeals for the Second Circuit in this case, an inventor was entitled to claim at any time, either in his original patent or in a division, anything he disclosed, whether or not he initially recognized it as an invention or the necessity for claiming it specifically, unless there was an intervening adverse public use, patent or printed publication more than two years before the assertion of the claims.

The new rule laid down in the case at bar penalizes the inventor who discloses more than a single invention in his original application, and thus discourages the complete and prompt filing heretofore induced by the benefits accorded divisional applications. By withholding such disclosures the inventor incurs only the risk that some bar under the statute (Sec. 4886 U. S. C., title 35, sec. 31, p. 5, *ante*) may arise.

By filing them, he incurs, under this rule, the obligation of continuously claiming *specifically* everything initially described under the penalty that, if he overlooks or for any reason fails to claim some phase of his disclosure for a period of more than two years, *prima facie* he is not entitled to a patent thereon, whether there has been an adverse intervening right or not. Never before has such a drastic rule been laid down with respect to divisional applications.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

Your petitioner respectfully prays that the writ be allowed for the following reasons:

1—Because the decision of the Circuit Court of Appeals for the Second Circuit is in direct conflict with decisions of the Circuit Court of Appeals of the First Circuit in *Utah Radio Corp. Products v. Boudette*, 78 F. (2d) 793, and of the Circuit Court of Appeals for the Sixth Circuit in *Wagenhorst v. Hydraulic Steel Co.*, 27 F. (2d) 27, and *Wirebounds Patents Co. et al. v. Saranac*, 37 F. (2d) 830, and the decisions of the Sixth Circuit are in conflict with the decision of the Circuit Court of Appeals of the Eighth Circuit in *Hartford-Empire Company v. O'Bear-Nester Glass Co.*, 39 F. (2d) 769, which to an extent supports the decision of the Court of Appeals in the case at bar. See *supra*, pp. 4, 6.

2—Because the decision of the Circuit Court of Appeals for the Second Circuit misinterprets and misapplies the decision of this Court in *Webster Co. v. Splitdorf*, 264 U. S. 463. See *supra*, pp. 4, 6.

3—Because the decision of the Circuit Court of Appeals for the Second Circuit overturns the practice of the Patent Office, as it has existed for more than fifty years, with respect to the right of an applicant to present claims in a divisional application. See *supra*, p. 5.

4—Because the public interest and the interest of inventors require that the rights and duties in respect to the presentation of claims in divisional applications and the rule

of law on the subject be defined and explained so that the Patent Office and the courts of the several circuits may be instructed in the application of the rule to particular states of facts to the end that reasonable uniformity of decision among the circuits may be restored. See *supra*, pp. 9, 11.

PRAYER.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the decree of the Circuit Court of Appeals for the Second Circuit be reversed; and that petitioner be granted such other and further relief as may be proper.

CROWN CORK & SEAL COMPANY, INC.,

By THOMAS G. HAIGHT,

GEORGE F. SCULL,

JOHN J. DARBY,

GEORGE W. PORTER,

Counsel for Petitioner.

BLANK

PAGE

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of Courts Below.

The opinion of the District Court (Campbell, J.,) is found at pages 2071 and 2090 of the record and is reported in 14 F. Supp. pp. 264 and 270.

The opinion of the Circuit Court of Appeals (Circuit Judges Manton, L. Hand and Swan; Judge Swan writing, Judge Manton dissenting) is reported at 86 F. (2d) 698, 701 and appears at page 2150 of the record.

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered December 21, 1936 (R., p. 2156). Petition for rehearing was denied January 22, 1937 (R., p. 2157). Extension of thirty days from April 22, 1937 for filing petition for certiorari was granted by Mr. Justice Stone on April 8, 1937 (R., p. 2159).

The Statute giving jurisdiction is Section 240 (a) of the Judicial Code (28 U. S. C. Sec. 347).

Statement of the Case.

The foregoing petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ, as well as a statement of the questions involved in the case.

Specification of Errors.

1. The Circuit Court of Appeals for the Second Circuit erred in finding and holding that a two year time limit for presenting claims in a divisional application, as announced by this Court in *Webster Co. v. Splitdorf Co.*, 264 U. S. 463, is applicable in the present case and in the absence of adverse public use, patenting or publication more than two years before the presentation of the claims.

2. The Circuit Court of Appeals for the Second Circuit erred in ignoring the apparent and intended breadth of the claims in the parent patent and in not holding that since these claims were believed and intended to be, and apparently are, of a breadth to cover the subject-matter of the divisional patent, the delay in presenting the claims in the divisional patent is excused.

3. The Circuit Court of Appeals erred in reversing and in not affirming the decree of the District Court sustaining the parent and divisional patents as valid and infringed, and in awarding costs to defendant-respondent.

ARGUMENT.

I.

The Circuit Court of Appeals for the Second Circuit has extended the doctrine of *Webster v. Splitdorf* beyond anything justified by that or any other decision of this Court.

In *Chapman v. Wintroath*, 252 U. S. 126, this Court reiterated the rule that a divisional application is entitled to the benefit of the filing date of the parent application "with all its priority of right" and for anything disclosed in the parent application, whether claimed in the parent application or not. In the same case this Court also stated, as an exception to that rule, that where a patent has issued to another more than two years before its claims are copied by a divisional applicant for interference purposes, the lapse of such a period bars the divisional applicant from copying and obtaining the claims in the issued patent.

In *Webster Co. v. Splitdorf Co.*, 264 U. S. 463, this Court announced a further exception to the rule that a divisional application relates back to the filing date of the parent application.

The facts of the *Webster* case briefly were: The original application for the Kane patent in suit was filed Feb-

ruary 2, 1910. In 1915 Kane filed a divisional application, in the prosecution of which on June 17, 1918, claims were presented to subject-matter *deliberately* not claimed either broadly or specifically in the original application, because Kane considered their subject-matter one merely of design. *These claims were presented five years after a complete disclosure of their subject-matter appeared in an issued Podlesaks patent and an equal length of time after the device had been in general public use.* This Court found "that Kane did not originally intend to assert" the claims, that the claims were "broader than those originally sought" and "that the delay was unreasonable, and, under the circumstances, as shown by the record, constitutes laches" by which Kane lost his right to a patent on the subject-matter of the late presented claims.

We do not understand that this Court held in *Webster v. Splitdorf*, as stated by the Court of Appeals for the Second Circuit, that in *any* case where there has been a delay of more than two years in presenting claims in a divisional application, such delay, *even in the absence of public use or intervening rights*, invalidates the delay in the absence of excuse. The facts in the case at bar are not analogous to those in the *Webster* case. While here there was a lapse* of more than two years in presenting the claims of the divisional patent, *yet here had been no adverse public use of the invention before or during the two-year period. Nor had there been any disclosure of the invention in an issued patent or printed publication, except the Johnson patent No.*

*In the case at bar, the Court of Appeals, reversing the District Court, held that there was a lapse *after previous claiming of the divisional patent invention* and not delay with no previous claiming, as in the *Webster* case. The Court of Appeals found that Warth had claimed the divisional patent subject-matter in his parent application, but that there was a lapse in the assertion of claims thereto between December, 1930 and April, 1933 (R., p. 2153). Hence, this case is distinguished from the *Webster* case where the invention had not been claimed in the parent application and the failure was deliberate.

1,852,578 (R., p. 746), which issued *only a year* before the claims were asserted, and, therefore, well within the two year period allowed for copying the Johnson claims under the *Chapman* case, *supra*. Moreover, as the Court of Appeals found, Warth had claimed broadly the subject-matter of the divisional patent during the pendency of his parent patent, and hence there was no *deliberate* failure to claim the subject-matter prior to claiming it in the divisional application. On the contrary, the Court of Appeals held that Warth did prosecute in the parent application claims covering the subject-matter of the divisional patent (R., p. 2151). Further, Warth *believed* he had covered the invention of the divisional patent by the claims issued in the parent patent. The claims of the parent patent *apparently are* of such breadth; the District Court so held (R., p. 2082) although the Court of Appeals later construed narrowly the parent patent claims.

In short the Court of Appeals held that Warth's unintentional *lapse* in claiming the specific divisional patent method for two years and four months, *absent intervening rights*, is the equivalent of the eight year *deliberate delay and failure* to claim an invention, considered in the *Webster* case, *where public rights in the meantime accrued*. On this finding, the Court has denied Warth the benefit of the general rule that the divisional patent relates back to the filing date of the parent patent.

The uncertainty with respect to the exception to this general rule announced in the *Webster* case, is recognized by the Circuit Court of Appeals for the Sixth Circuit in *Wagenhorst v. Hydraulic Steel Co.*, 27 Fed. (2d) 27, 29, (Denison, J.,) where the Court said, referring to the *Webster* case:

"It is not clear from the opinion what result would have been reached, if based upon only a part of the circumstances."

The Court (C. C. A. 6th) then proceeded to point out that the controlling fact in the *Webster* decision was not the fact that the claims were presented after delay "*but because it extended so long after the 1913 public disclosure*". This, we believe to be the correct interpretation of this Court's decision in the *Webster* case.

The extreme harshness of the rule announced by the Circuit Court of Appeals for the Second Circuit is evident from the fact that it applies to divisional applications a two year time limit which is not imposed upon them by the fundamental statute.* The statute bars the allowance of a patent *only if there has been a printed publication, public use or sale of the invention more than two years before the filing date of the application*. The rule established by the Court of Appeals for the Second Circuit requires an excuse for delay and *prima facie* bars a patent whether statutory bars, as such or by analogy, exist or not. The rule, as applied in this case, therefore, contrasts with the statement of this Court in *United States v. American Bell Telephone Co.*, 167 U. S. 224, 247, that "No court can disregard any statutory provisions in respect to these matters on the ground that, in its judgment, they are unwise".

In the present case, aside from the admitted use of the invention by plaintiff,** neither the District Court, nor the Court of Appeals, found evidence of any use of the invention or public disclosure thereof more than two years before the filing of the divisional application. Consequently, under the rule of the Circuit Court of Appeals for the Second Circuit a divisional application is not entitled even to the benefit of its own filing date if there has been a two-year lapse in claiming its subject-matter.

*U. S. C., title 35, sec. 31, p. 3 of Petition.

**Held by the Circuit Court of Appeals for the Sixth Circuit in *Wirebounds Patents Co. et al. v. Saranac*, *infra*, p. 23, not to bar a divisional application since not an *adverse* use.

The Court of Appeals found no statutory bars and refers only to the issuance of the parent Warth patent and to the issuance of the Johnson patent during the two year period. But the parent Warth patent *contained no description of the invention*, and hence was not a printed publication. The Johnson patent issued *less than one year* before the claims were presented, and hence is not a bar under the decision of this court in *Chapman v. Wintroath, supra*. Consequently, the Court of Appeals for the Second Circuit overlooks the admonition of this Court in the *Chapman* case with reference to a patent such as Johnson's that:

"Such a prior patent is in no sense a bar to the granting of a second patent for the same invention to an earlier inventor, provided that his application is filed not more than two years after the date of the conflicting patent. The applicant may not be able to prove that he was the first inventor but the statute gives him two years in which to claim that he was and in which to secure the institution of an interference proceeding in which the issue of priority between himself and the patentee may be determined in a prescribed manner."

Warth acted in compliance with the above rule, copied the Johnson claims within one year from the date his patent issued, and was awarded the claims as prior inventor.

II.

There is an irreconcilable conflict between the Circuit Courts of Appeals for the Second, First, Sixth and Eighth circuits as to the applicability of Webster v. Splitdorf to a case where claims have been inserted in a divisional application more than two years after the filing of the parent application but less than two years after there was an intervening public use, patent or publication.

The Circuit Court of Appeals for the Second Circuit has evidently seized upon this Court's reference in the *Webster* case to the two year limit against broadened reissue pat-

ents* as a basis for its holding that when there has been a lapse of two years in presenting claims to particular subject-matter in a divisional application, such delay invalidates the claims in the absence of valid excuse, *notwithstanding the fact that there may have been no adverse public use of the invention or disclosure of it in a printed publication or patent more than two years prior to the date the claims are presented, as there was in the Webster case.*

The interpretation of the *Webster* case by the Circuit Court of Appeals for the Second Circuit directly conflicts with the interpretation adopted by the Court of Appeals for the First and Sixth Circuits whose decisions are discussed in the foregoing petition at pp. 5, 6. The following extracts from the opinion by these latter Circuits demonstrate that each of them construed the doctrine of *Webster v. Splitdorf*, as applicable **only** where the claims of the divisional application were first presented more than two years after the invention was disclosed to the public by adverse use, publication or patent.

Utah Radio Corp. Products Co. v. Boudette, (C. C. A. 1st), 78 Fed. (2d) 793.

The Court, stating the facts of the *Webster* case, pointed out that the subject-matter of the divisional claims had been disclosed in a Podlesaks patent issued over five years before the claims were first presented and had been in public use by others than the patentee for over five years. The court said (at 799) after referring to the *Webster* case, that claims may "reasonably" be presented at any time within two years after the adverse public use:

*There is no analogy in the case at bar to an application for re-issue filed more than two years after the original patent issued, since there was no printed disclosure in the parent Warth patent, as in the case of an original patent to be reissued. Hence, this analogy mentioned in the *Webster* case does not apply.

“In that (*Webster*) case the court applied by way of analogy *the statutory two year period of prior publication and public use* * * *

“There the subject-matter of claims 7 and 8, though not claimed in the Podlesaks patent, *was disclosed by it, and consequently, on the issuance of that patent in 1913, was published and given to the public.*”

“In the case now before us, the subject-matter of claims 1, 2, and 5 here in issue was known and in public use through the sale of RCA loudspeaker 104 in November, 1925, some four years before claims 1, 2 and 5 were asked for, whereas *they reasonably could have been inserted in the original application of April, 1926, or at any time thereafter up to two years from November, 1925, but were not until October 17, 1929, when the divisional application was made.*”

* * * * *

Wagenhorst v. Hydraulic Steel (C. C. A. 6th) 27 F. (2d) 27, 29.

The Court (Denison, J.,) after reciting the facts of the *Webster* case said:

“From the recitals and reasoning of the opinion, we are unable to see that the fact that the amendment of 1918 was presented in a divisional application, instead of an original application, was of any importance to the result reached. The long delay which elapsed between the original and the divisional was important, *not because it was the interval between these two applications, but because it extended so long after the 1913 public disclosure.* If the original application of 1910 had not matured into a patent in 1916, but had continued pending, and the amendment in 1918 had been offered in that original application, and the facts had been otherwise the same, we see nothing in the opinion, and no reason occurs to us which would indicate a different result. In other words, claims 7 and 8 were invalid because, in an effort to *broaden any previous statements of the invention, they were first presented by an amendment offered five years after their subject-*

matter had been disclosed to the public by the Podlesaks patent; and such an effort to broaden the claim of the invention was, by analogy to the reissue rule, barred by laches, estoppel, and intervening rights. In the present case the divisional application was filed promptly after the intervening device appeared, and the Webster case does not apply."

* * * * *

Wirebound Patents Co. et al. v. Saranac, (C. C. A. 6th), 37 F. (2d) 830, 840, 841.

The District Court had held the patent in suit invalid under the ruling in the *Webster* case. The Court of Appeals (Denison, J.,) discussing the *Webster* case said:

"This was before we had by our *Wagenhorst* case, * * * adopted our interpretation the *Splitdorf* decision." * * *

"This case is plainly not within the *Splitdorf* rule, as we understand it, either by parallelism or by strict analogy. Defendant points out, as a general analogy, that the machine and method had been in public use by the applicants, who became the patentees, and under licenses from them, all for more than two years before the divisional application was filed. This is true. When it is remembered that the divisional application is normally entitled to the benefit of the original filing date, it is not easy to see how public use under license from the applicants can amount to that laches under which adverse rights may arise; or how the *Splitdorf* rule can apply unless the delay is after the public appearance of an adverse claimant, or perhaps, one who may be an adverse claimant; but we find it unnecessary to decide that question."

The decision by the Circuit Court of Appeals in the case at bar also conflicts with the interpretation of the *Webster* case adopted by the United States District Court for the District of Delaware (Morris, J.,) in *Dubilier Condensor*

Corporation v. Radio Corporation of America, 34 F. (2d) 450, 462.*

The Courts of the First, Third and Sixth Circuits have, therefore, restricted the application of the ruling in the *Webster* case to a situation in which the invention has been generally made available to the public more than two years prior to the presentation of the claims either by disclosure in another patent or by adverse public use or sale. Such facts create bars recognized by the statute (U. S. C. title 35, sec. 31, p. 3 *ante*) against the issuance of patents on an original application and therefore afford a basis for a finding of invalidity on grounds analogous to those created by the statute. But there is no such basis here.

The Circuit Court of Appeals for the Eighth Circuit has held in *Hartford-Empire Co. v. O'Bear-Nester Glass Co.*, 39 F. (2d) 769, upon the authority of this Court's decision in the *Webster* case, that although claims may be presented in a divisional application after the lapse of more than two years, yet where in the meantime a patent "shall have been issued to a *stranger* more than two years after the original applicant files his original application" the claims are barred. In that case, the court after referring to *Webster v. Splitdorf*, *Chapman v. Wintroath* and the *Wagenhorst* case, *supra*, said (at 776):

(3) "(d) Absent estoppel in pais, through accrual of public or private rights, such amendments of claims, or the filing of such divisional applications, may be allowed more than two years after the original application is filed, or after the last preceding divisional ap-

*In the *Dubilier* case the Court, after referring to the fact that the claim (9) was not submitted until three and one-half years had elapsed after the divisional application was filed, said, in distinguishing the facts from the *Webster* case and others:

"But unlike those cases, in the suit at bar there was no delay of more than two years *after others had entered the field* and there is no presumption that Dunmore had knowledge of defendant's loud speaker, or that the amendment was motivated by it."

plication is made. (e) *But if a patent, which makes claim to the subject-matter present and disclosed in the application of the original applicant, but not claimed by the latter, shall have been issued to a stranger more than two years after the original applicant files his original application, the latter can thereafter neither amend his original claims (so as to broaden them) nor file a divisional application, embracing claims, so after two years patented to a stranger."*

The above quoted ruling squarely conflicts with the decision by this Court in *Chapman v. Wintroath*, *supra*, but apparently would have justified the conclusion reached in the case at bar, since the Warth divisional application was not filed until more than two years after the original Warth application and the Johnson patent No. 1,852,578 was granted before the divisional patent claims were asserted.

The ruling of the Circuit Court of Appeals for the Eighth Circuit in the *Hartford* case, *supra*, also squarely conflicts with the ruling of the Sixth Circuit Court of Appeals in the *Wagenhorst* case, *supra*, where the Court said:

"The opinion (*Chapman v. Wintroath*) has been sometimes thought to indicate that the deadly two-year period begins to run from the time of filing the original application * * *,"

and then proceeded to state its own contrary interpretation of this Court's decision in the *Chapman* case.

This further conflict between the Second and Eighth Circuits on the one hand, and the First, Third, and Sixth Circuits on the other, shows the great uncertainty which has arisen with respect to the meaning of this Court's decision in *Webster v. Splittorf*.

III.

There is a further irreconcilable conflict between the Circuit Courts of Appeals for the Second and Sixth Circuits as to what constitutes valid excuse for delay in presentation of claims in a divisional application.

This Court said in the *Webster* case that delay of more than two-years may be excused "by special circumstances which show it to have been not unreasonable". The finding by the Circuit Court of Appeals for the Second Circuit in the case at bar that there is no excuse for the delayed presentation of the claims in the Warth divisional patent ignores the *apparent* and *intended* breadth of the claims in the parent patent. The Court of Appeals stated (R., p. 2153) that, had it interpreted the claims of the parent patent to dominate the method of the divisional patent, the delay in presenting the specific divisional patent claims would be excused. But the Court refused to accept as an excuse for the delay the "special circumstance" that the parent patent claims were *intended* and *believed* to dominate the divisional patent method, *and were reasonably susceptible to such an interpretation*, as shown by the fact that the District Court so interpreted them.

The Court of Appeals tacitly admitted that the parent patent claim *might* be interpreted in accordance with the District Court finding, but said that such interpretation "would make it invalid under the old 'slide machine' " (R., p. 2152). Consequently, the Court declined to follow the District Court, and instead read into the claims the "heated plunger" limitation.** Such a construction of patent claims was condemned by this Court in *Altoona v. American Tri-Ergon*, 294 U. S. 477. Manifestly, Warth should not be held

*This was the machine used by plaintiff before the methods of the patents in suit were developed.

**We have included in an appendix an explanation of the Warth patents sufficient to enable the Court to understand the strained construction of the claims to which the Court of Appeals resorted.

accountable for failure to anticipate the action of the Court of Appeals in inserting a limitation into his claims which the language thereof does not require. Certainly, Warth's confidence in the breadth of the parent patent claims was not "unreasonable", in view of the fact that the District Court later found that the claims *do* dominate the subject-matter of the divisional patent. Under these circumstances, we submit that Warth's action in relying upon the parent patent claims was reasonable and satisfies the requirement laid down by this Court in the *Webster* case that delay may be overcome by "circumstances which show it to have been not unreasonable".

The limited construction of the parent patent claims adopted by the Court of Appeals is particularly strained in the case at bar, since the heated plunger (read into the claims) was not originally disclosed by Warth in his parent application as filed, and was illustrated and described by an amendment presented in response to a *Patent Office requirement* (R., p. 1497) for a drawing. When the drawing was presented, the illustrated heated punch was identified only as "suitable mechanism" for practicing the method broadly described" (R., p. ~~1498, 1514~~ 1514, *l. 31*).

The refusal by the Court of Appeals to accept the *intended* and *apparent* breadth of the parent patent claims, upon which Warth reasonably relied to dominate the divisional patent preheating method, as an excuse for the delay, conflicts with the ruling by the Court of Appeals for the Sixth Circuit in *Wagenhorst v. Hydraulic Steel Co.*, 27 F. (2d) 27, 31, in which the Court held that a claim in the parent application or patent which *seems* of broad scope, *regardless of the finally determined actual scope*, is a reasonable excuse for the delay. The Court said in the *Wagenhorst* case:

"It may be said, with some certainty as to original claim 2, and with some probability as to claims 1 and 3, that, if granted, they would *have seemed to cover defendant's later structure, and might or might not have been construed in that way.* The trouble was that with

that construction they went beyond the applicant's device and reached the prior art. Wagenhorst's amended divisional claim restricted his claimed invention to the specific form of its concrete embodiment. This is a very different thing from the enlargement in the Webster case."

An apparently broad claim in an earlier application or patent, and an inventor's reliance thereon, even though mistaken, has been held by other Courts to be an excuse for delay in asserting claims, and to negative abandonment. See *McGrath v. Burke*, 12 F. (2d) 161, 162 (Appeals, D. C.) and *MacLaren v. Stoetzel* (C. C. P. A.) 38 F. (2d) 125, 129.

Since, as the Court of Appeals stated, Warth's delay would not have been "unreasonable" had his parent patent claims been construed to cover the subject-matter of the Warth divisional patent claims, the secondary question is simply this—

Should the criterion of the diligence of an applicant in presenting specific claims in a divisional application be (a) the scope of the parent patent claims finally determined by judicial construction, as held by the Second Circuit, or (b) as held by the Sixth Circuit, the *seeming* or *apparent* scope of the parent patent claims reasonably* *relied upon* and *intended* by the patentee?

We submit that the latter is the correct rule since one's diligence at a particular time should be measured in the light of the circumstances (parent patent claim scope) as then reasonably understood by him, and not as later and unexpectedly determined upon judicial inquiry.

IV.

The questions involved are of vital public importance.

Under the statutes, the patent is issued to the first discoverer. But an invention is not completed until it has been reduced to practice, either actually or constructively by the

*As indicated by the District Court's opinion in the case at bar.

filing of an application. This Court stated in *Chapman v. Wintroath, supra*, "not only have later or divisional applications not been dealt with in a hostile spirit by the Courts, but, on the contrary, designed as they are to secure the patent to the first discoverer they have been favored."

The substantial number* of divisional applications and patents are the result of requirements by the Patent Office that applications disclosing several inventions must be divided so that only a single invention is covered in a single patent. These requirements have not diminished the completeness of application disclosures, because of the liberal policy with which the Patent Office and the Courts have generally favored divisional applications.

But it must be recognized that many divisional applications are not, and cannot be filed within two years from the filing of the original application. In many cases, it is only in the course of prosecution after a lapse of two years, that an inventor is caused to realize, as here, the necessity for *specific* claims to particular phases of his disclosure. This delayed recognition of the need for specific claims frequently results in later filed divisional applications. *Such exigencies are not recognized by the decision of the Court of Appeals for the Second Circuit*, which in the case at bar has applied the harsh rule that a two year delay in presenting claims by divisional applications creates a presumption against the patent validity. It is vital, therefore, in view of the varied conditions under which the necessity for divisional applications arises, and for a continuance of the policy of favoring these applications, that this Court definitely state the *limitations* of the *Webster* case exception to the rule that divisional applications shall have the priority rights of parent cases. Unless and until this is done, the public and inventors alike will have no certainty as to when, and under what conditions, divisional applications may be filed or valid divisional patents granted.

*See typical figures in Petition, footnote p. ¹⁰~~2~~, ante.

Conclusion.

In conclusion, we respectfully submit that not only should the conflict between the several circuits with respect to *Webster v. Splitdorf* be resolved by an authoritative statement by this Court, but also that this Court should hold—

(a). That claims in a divisional application shall be deprived of the benefit of the filing date of the parent application only when there has been a delay in presenting them for more than two years after an intervening right in the form of an adverse public use or disclosure, such as a printed publication or patent.

(b). That a mere lapse of two years in presenting claims in a divisional application does not prima facie bar their allowance or require excuse.

(c). That when an inventor has obtained in a parent patent claims which are intended and believed to, and apparently do, cover the subject-matter of the claims of the divisional patent, his delay in presenting specific claims in the divisional patent is excused.

Respectfully submitted,

THOMAS G. HAIGHT,
GEORGE F. SCULL,
JOHN J. DARBY,
GEORGE W. PORTER,
Counsel for Petitioners.

Appendix.

The method of the parent Warth patent Reissue 19,117 (R., p. 711), is illustrated by the attached drawing. A line of assembled crowns* is fed step by step beneath a heated punch. A strip of facing material coated with a thermoplastic (heat-softened) adhesive, such as metal foil coated with gutta percha, is fed over a line of assembled crowns, a spot is punched from the strip and the punch carries the spot down and adheres it under heat and pressure (from the punch) to the cork disc of the assembled crown. The cutting punch is then raised and the crown moved to the next position where the spot is again subjected to pressure from a heated plunger, thus insuring a more perfect union. Finally, the now-spotted crown is held under a cold plunger until the adhesive is cool. This operation is performed at the rate of five hundred "spots" per minute for each punch (R., p. 96).

The Warth divisional patent No. 1,967,195, dated July 17, 1934 (R., p. 716) covers a method also illustrated by an attached drawing. The divisional patent differs from the parent patent, in that it describes the heat as being applied to the spot by preheating the cork disc which applies its heat to the spot and the claims are limited to this specific way of applying the heat to the spot. In other words, the cork disc is preheated so that at the instant the center spot is deposited, heat is applied to the spot from the cork disc.

The relationship of the two patents can be best explained by referring briefly to the history of the parent patent. The application for the parent patent filed in January, 1927 disclosed generally the step of applying heat and pressure to the spot at the instant it is deposited on the cork. It also specifically explained that the heat might be applied to the spot by preheating the cork disc. The method was claimed broadly while the application was pending, but no claims

*"Assembled crown" designates a metal shell of the crown type having a cork disc inserted therein.

specific to preheating the cork were presented. Shortly before the issuance of the parent patent, the reference to preheating the cork was cancelled, and there was substituted the **broad**er expression that the invention is "*to utilize at the time of assembly both heat and pressure to unite the spot to the cork*" (R. p. 714 l. 47). At the same time the claims were amended to include the expression "upon assembly applying simultaneously to the spot pressure and sufficient heat to render the adhesive tacky." The patent issued with this language in the specification and claims. Claim 3* is typical of the two parent patent claims in suit.

The District Court held (R., p. 2082) that the language of the parent patent specification and claims covered broadly the application of heat and pressure to the spot instantly upon assembly of the spot with the cushion disc, *regardless of the source of heat, i. e., whether by the punch, as described in the parent patent, or by a preheated cork, as described and claimed in the divisional patent.* The Court of Appeals held that the expression "*applying simultaneously to the spot pressure and sufficient heat*" limits the claims to the application of heat to the spot by a heated plunger. As thus interpreted, the Court read the

•3. The improved method of manufacturing caps of the type having an interior disc of cushion material provided on its exposed face with a center spot, which comprises providing spot material in strip form having one surface formed of an exposed continuous coating of water resistant adhesive which is normally hard at room temperature but becomes tacky upon the application of heat and having another surface to be exposed to the contents of a capped container, cutting from said strip a facing spot having one surface completely coated with said adhesive with a cap disposed beneath the portion of the strip from which the spot is cut, whereby the cutting operation positions the spot upon the cushion material with the coating between the spot and the cushion material, *and upon assembly applying simultaneously to the spot pressure and sufficient heat to render the adhesive tacky*, thereby causing the spot to adhere to the cushion material and thereafter permitting the adhesive to cool and harden while subjecting the assembled unit to pressure. (Italics ours.)

"heated plunger" into the claims so that the clause reads, (containing in italics the limitation inserted by the Court):

"upon assembly applying simultaneously to the spot *by a heated plunger* pressure and sufficient heat to render the adhesive tacky".

Under this interpretation, the Court of Appeals reversed the District Court and held that the defendant did not infringe the parent patent because the defendant applied the heat mainly by preheating the cork, although partly by a heated plunger.

WARTH PARENT PATENT METHOD WARTH REISSUE No. 19117 - MARCH 20, 1934. ORIGINAL FILED JANUARY 7, 1927.

FIRST STEP

FACING MATERIAL
METAL FOIL OR PAPER

POSITIONING THERMOPLASTICALLY COATED
STRIP BENEATH PUNCH AND OVER CROWN

COATING OF
THERMOPLASTIC
ADHESIVE

PUNCH

GAS HEATER

PUNCH

GAS HEATER

GAS HEATER

DIRECTION OF CROWN TRAVEL



ASSEMBLED CROWN



ASSEMBLED CROWN

SECOND STEP

EMPLOYING PUNCHING OPERATION
TO POSITION SPOT CENTRALLY ON
CUSHION DISC

THIRD STEP

ADHERING SPOT TO DISC BY
HEAT AND PRESSURE

FOURTH STEP

APPLYING HEAT AND
PRESSURE AFTER
PLACING SPOT.

FIFTH STEP

COOLING WHILE
APPLYING PRESSURE

WARTH DIVISIONAL PATENT METHOD WARTH PAT. No 1,967,195 - JULY 17, 1934

FIRST STEP

FACING MATERIAL
 METAL FOIL OR PAPER

POSITIONING THERMOPLASTICALLY COATED
 STRIP BENEATH PUNCH AND OVER CROWN.

COATING OF
 THERMOPLASTIC
 ADHESIVE

PUNCH

PUNCH

DIRECTION OF CROWN TRAVEL

GAS HEATER

GAS HEATER

ASSEMBLED CROWN

PRELIMINARY HEATING OF
 CUSHION DISC TO PROVIDE
 HEAT FOR THIRD STEP

SECOND STEP

EMPLOYING PUNCHING OPERATION
 TO POSITION SPOT CENTRALLY
 ON CUSHION DISC

THIRD STEP

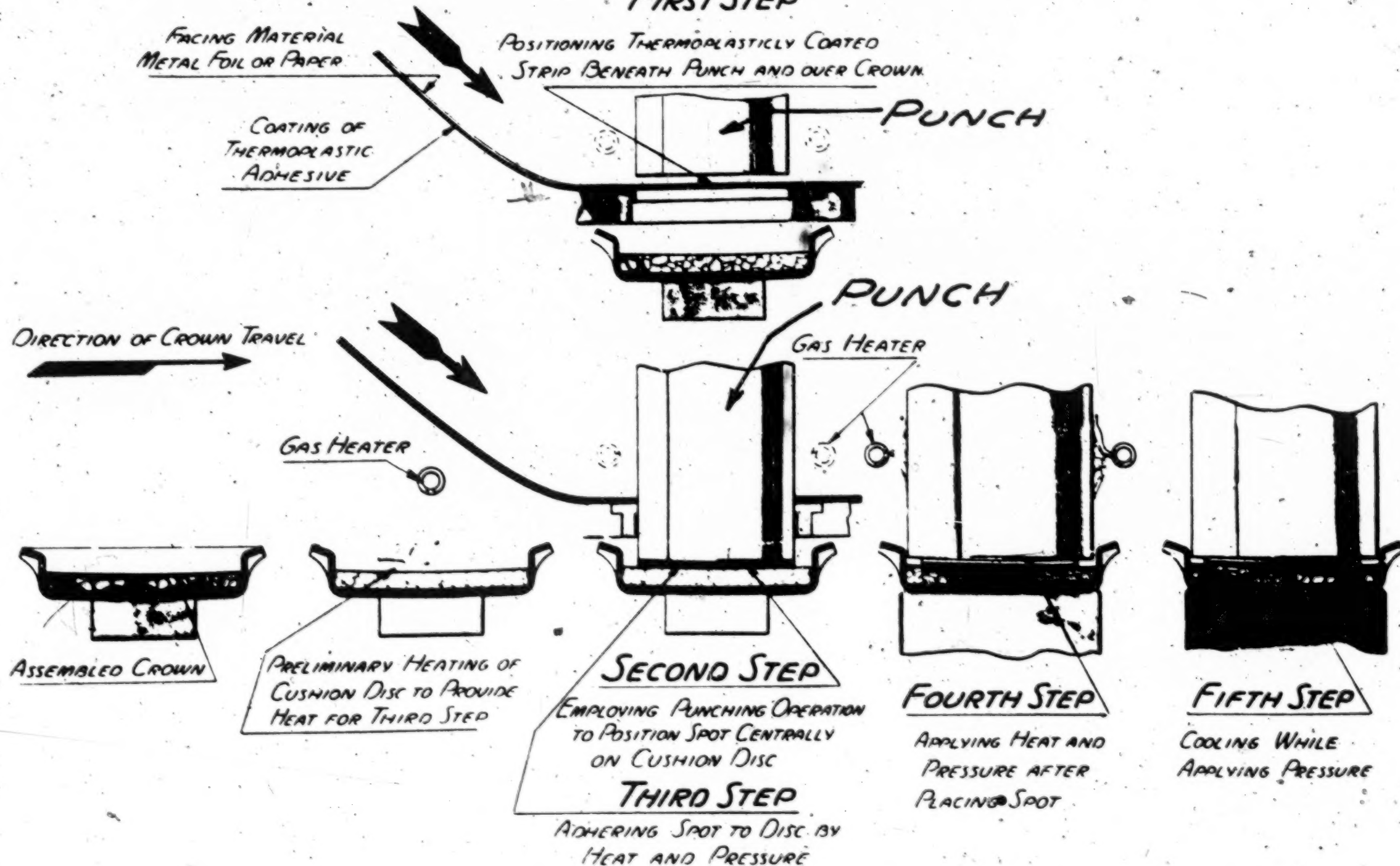
ADHERING SPOT TO DISC BY
 HEAT AND PRESSURE

FOURTH STEP

APPLYING HEAT AND
 PRESSURE AFTER
 PLACING SPOT

FIFTH STEP

COOLING WHILE
 APPLYING PRESSURE



BLANK

PAGE

CENTER SPOT CROWN CAP

